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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,886	09/19/2008	Andrew Ward-Askey	3004535-7049118001	9925

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EXAMINER	
FAISON GEE, VERONICA FAYE	
ART UNIT	PAPER NUMBER
1793	
MAIL DATE	DELIVERY MODE
12/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/573,886	WARD-ASKEY ET AL.	
	Examiner	Art Unit	
	VERONICA FAISON GEE	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Claim 6 has been amended and claims 9-10 are canceled. Hence, claims 1-8 are pending in the application.

Applicant's arguments are persuasive to the extent that the rejection over Sekioka in view of EP 0 846 569.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 846 569.

EP 0 846 569 teaches a coating composition comprising a color forming system which comprises chromogenic material (electron-donating dye) and acidic developer material; polymeric binder material, surface active agents and other additives in an aqueous medium. The composition can additionally contain inert pigments, such as clay, talc, aluminum hydroxide, calcined kaolin clay, and calcium carbonate (page 3 lines 24-27, 47-50). The reference further teaches that the electron-donating dye may comprise 3-dibutylamino-6-methyl-7-anilino-fluoran and the developer may be Bisphenol A (page 4 lines 8-41). The reference discloses that a dispersion of a particular system component has a particle size of between about 1 microns and 10

microns. The examples disclose that sensitizer may be dimethylterephthalate and PVA (polyvinyl alcohol).

EP 0 846 569 is described above, but fails to specifically exemplify the use of the combination of 3-dibutylamino-6-methyl-7-anilinofluoran, bisphenol A and dimethyl terephthalate as claimed by applicant. See examples for method of preparing a thermal ink. Therefore, it would have been obvious to one of ordinary skill in the art to use of 3-dibutylamino-6-methyl-7-anilinofluoran, bisphenol A and dimethyl terephthalate as claimed by applicant as EP 0 846 569 also discloses the use of combination of 3-dibutylamino-6-methyl-7-anilinofluoran, bisphenol A and dimethyl terephthalate but shows no example incorporating them.

The reference remain silent the particle size of the pigment. However, the particle size of pigment that may be acceptable is dependent on upon the use of the composition and one of ordinary skill what particle is suitable for the intended use, as evident by the particles size of the dispersion.

With respect to claims 5 and 6, when general conditions (particle size of solids) are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230).

Response to Arguments

Applicant's arguments filed 10-9-09 have been fully considered but they are not persuasive.

Applicant argues that EP 0 846 569 is concerned with the stability of an image obtained once a thermal image has been produces on thermal paper and that the invention is concerned with the face that thermal papers tend to discolor on storage before development of an image using a thermal paper.

It appears that Applicant is arguing the intended use of the composition and not the actual composition. As the reference disclose all the components of the invention.

The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Applicant also appears to be arguing unexpected results by pointing to the experimental evidence.

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art

derived the disclosed subject matter from the applicant. See, for example, In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the ***closest prior art***, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); Ex parte George, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

However, arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., In re Huang, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); In re De Blauwe, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENGO/
Supervisory Patent Examiner, Art Unit 1793

/Veronica Faison-Gee/
Examiner, Art Unit 1793